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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,625	01/09/2002	Francis Ambrose Broderick	FR920000074US1	4352

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EXAMINER	
DESHPANDE, KALYAN K	

ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/042,625	BRODERICK ET AL.	
	Examiner	Art Unit	
	Kalyan K. Deshpande	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. The following is a non-final office action in response to the communications received on April 28, 2008. Claims 1-8 are now pending in this application.

Response to Amendments

2. No amendments to the claims have been submitted with this reponse.

Response to Arguments

3. Applicants' arguments have been fully considered but are moot under new grounds of rejection. Applicants have submitted an affidavit under 37 C.F.R. 1.131 declaring that Applicants date of invention pre-dates the Ruffin references. Such a declaration is deemed effective. Applicants additionally argue that this affidavit also declares the Ruffin reference only as a 102(e) reference and that IBM Corp. was the assignee of the Ruffin reference at the time of filing (see Remarks p. 5 submitted on March 27, 2008), HOWEVER, no such declaration can be found in the submitted 37 C.F.R. 1.131 declaration. Examiner has removed the Ruffin reference from the rejection and thus such arguments would moot regardless.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alter (Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996) in view of Lacity (Lacity, Mary; Willcocks, Leslie P.; "An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience", MIS Quarterly, Sept. 1998) and in further view of Willcocks et al. (Willcocks, Leslie; Choi, Chong; "Co-operative Partnerhip and 'Total' IT Outsourcing: From Contractual Obligation to Strategic Alliance?", European Management Hournal, March 1995).

As per claim 1, Alter teaches:

A project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment, said method comprising the steps of:

defining a project business need, the project business need being discrete and having a fixed duration (see pp. 552-553 and 558-559; where information systems plans are linked to a company's business plan. The critical success factors include business needs such as improving customer relationships, improving supplier relationships, making the best use of inventory, and using capital and human resources efficiently and effectively. Furthermore, these business needs are broken down into business processes and can be reengineered. The project is discrete and deadline and completion dates are set, thus the project has a fixed duration.). ;

defining a project technical need, the project technical need involving resources needed to realize the project business needs (see pp. 552-553; where specific

technical needs are determined and defined. The technical needs are resources that are needed to complete the project.);

determining, according to the project business need, a number of IT sites spread over a geographic area (see pp. 551-559 and 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines. The data centers are determined in accordance to the business needs.);

determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area (see p. 551-559; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks. The specific personnel are determined based on the technical requirements of the IS plan.);

grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area (see pp. 557 and 564-65; where skilled personnel and grouped in to general roles. Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well).

Alter fails to explicitly teach “physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic

site peculiarities, which include cultural differences, language differences, and legal constraints". Lacity, in an analogous art, teaches "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities" (see Lacity pp. 373, 376, and 384; where IT data centers (site) were consolidated in order to reduce costs.). Lacity fails to explicitly consider "cultural differences, language differences, and legal constraints" in its consolidation. Willcocks, in an analogous art, explicitly teaches "cultural differences, language differences, and legal constraints" in consolidating and outsourcing (see Willcocks pp. 69-71; where cultural differences, language differences, and legal constraints are considered in outsourcing.). The advantage of such a feature that it facilitates the success of an IS outsourcing plan. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the feature of "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal constraints" taught by Lacity and Willcocks to Alter in order to facilitate the success of the IS outsourcing plan, which is a goal of Alter (see Alter p. 552).

As per claim 2, Alter teaches:

The method of claim 1, further comprising the step of process and method standardization before the consolidating step, said process and method standardization step comprising the steps of:

listing processes and methods used in the IT sites as determined (see pp. 559 and 565-566; where corporate standards and procedures are determined);

listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed (see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures);

determining best processes and methods according to values of said criteria; and (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency),

implementing the best processes and methods in the IT sites as determined (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency).

As per claim 3, Alter teaches:

The method of claim 2 wherein the step of determining the best processes and method further comprises the steps of:

creating with a graphic user interface an evolutionary image of the values of the criteria (see p. 573; where a graph displaying costs, benefits and cumulative net benefit is created for a project); and

analyzing the image for determining the best processes and methods (see p. 573; where the image is analyzed to determined the value of the project).

Alter fails to explicitly teach entering the values into a database. It is old and well-known in the art to enter data into a database after it has been collected so that the data can be pulled to generate graphs and reports. The advantage of storing the data in a database is that the data can be easily accessible, thereby increasing the efficiency of the system. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to store data in to a database in order to increase the overall system efficiency, which is a goal of Alter (see p. 570).

As per claims 4 and 5, Alter fails to explicitly teach repeating the steps of listing criteria, determining best processes and methods, and implementing the best processes and practices. It is old and well known in the art to repeat steps in a process. The advantage of repeating steps is that repeating critical steps ensure the accuracy of the result of the steps. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to repeat the steps of listing criteria, determining the best processes and practices, and implementing the best processes and practices in order to ensure the accuracy of the results of the steps, which is a goal of Alter (see p. 570).

As per claim 6, Alter teaches:

The method of claim 5 wherein the IT sites are spread over more than one geographic area (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site

processing centers, department processors, workgroup processors, or at individual client machines.).

As per claim 7, Alter teaches:

The method of claim 6, further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the geographic area (see p. 557; where project manage roles are assigned. Each IS department or region is accounted for).

As per claim 8, Alter teaches:

The method of claim 7, further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of claim 1 (see p. 576; where a Gantt chart is a tool used to display a time for executing steps of a project).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art Unit 3625

/KKD/